

Claims 1, 2 and 12-14 have been rejected under 35 USC 102(b) as being anticipated by any of Shinosaki et al., JP 07-025946 (Shinosaki: all references will be to the English language translation), Noristi et al., U.S. 5,244,854 (Noristi), Ebara et al., EP 657 477 A2 (Ebara) and Yanagihara et al., EP 712 869 A1 (Yanagihara).

It is respectfully suggested that the rejection under 35 USC 102 is clearly erroneous. The requirements of a reference to be a proper anticipation are well established, as shown by the following quotation from a relevant legal precedent.

Rejection for anticipation or lack of novelty requires, as the first step in the inquiry, that all the elements of the claimed invention be described in a single reference. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir., cert. denied, 110 S.Ct. 154 (1989)). Further, the reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it. *Akzo N.V. v. United States Int'l Trade Comm'n*, 808 F.2d 1471, 1479, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987); *In re Coker*, 463 F.2d 1344, 1348, 175 USPQ 26, 29 (CCPA 1972).

In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990). See also *In re Marshall*, 578 F.2d 301, 304, 198 USPQ 344, 346 (CCPA 1978); *Ex Parte Levy*, 17 USPQ2d 1462 (BPAI 1990).

It should be immediately clear that, to whatever extent the examiner's rejection is based on the supposition that the polypropylene of the reference would have had "similar solubility behavior in xylene" (emphasis added), the rejection cannot be maintained. The statute and cited cases require that the references be the same, not similar to, the claimed invention for the rejection to be proper. As to the polypropylene in both instances being "the same," there is simply insufficient explanation to support such a supposition.

It is clear from the foregoing that the references do not describe the here claimed invention. Indeed, the examiner's rejection appears to be based on a supposed inherency of the here claimed invention in the reference disclosures. The issue of inherency has also been thoroughly treated in reported cases as follows.

"The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient [to establish inherency.]" *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981) (citations omitted) (emphasis added). "That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown." *In re Spormann*, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPQ 1966). Such a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection. See *In re Newell*, 891 F.2d 899, 901, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

In re Rijckaert, 9 F.3d 1531, 28 USPQ 1955, 1957 (Fed. Cir. 1993). See also *In re Felton*, 484 F.2d 495, 179 USPQ 295, 298 (CCPA 1973); *Ex Parte Levy*, 17 USPQ2d 1462 (BPAI 1990).

Again, there is no evidence of record or reasoning based on logic and sound scientific reasoning to support any presumption of inherency. As a factual matter, the finding of inherency is even more difficult to support since the references disclose undissolved polymer fractions in boiling heptane, i.e. at 98.4°C (Shinosaki), or boiling xylene, i.e. 137-140°C (Noristi), xylene at 105°C (Ebara) and xylene at 135°C (Yanagihara). There is no explanation of how those conditions would correlate with the temperatures recited in the instant claims, which describe a particular profile over a range of temperatures, a profile of a type not hinted at by the references, i.e., the entire concept is lacking from the prior art references.

With respect to claims 12-14, the product-by-process claims, the examiner has

failed to make out a *prima facie* case that the product of the references "reasonably" appears to be identical to the claimed products-by-process. *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972). The above cited cases of *In re Rijckaert, supra*, and *Ex parte Levy, supra*, particularly at 1463-64, are also pertinent to that issue.

Claims 3-11 have been rejected under 35 USC 103 as being unpatentable (obvious) over Shinosaki or Noristi.

In making this rejection, the examiner has evidently overlooked the fact that the instant claims require a special process and process sequence for preparing the Ziegler-Natta catalyst system, that is, using a C₁-C₈-alkanol in the first stage (page 2, line 9) and the extraction process in an inert solvent containing at least 5% by weight of titanium in the second stage (page 2, lines 20-21). There is of record no explanation of how the references would have led one of ordinary skill to the specific steps recited, in the specific order. For the requirements of a correct rejection under 35 USC 103, see MPEP §§ 706.02(j) and 2141-2143.03, and cases cited therein. Also see the cases cited above, particularly *Rijckaert* and *Levy* at 1463-64.

In light of the foregoing amendments and remarks, it is respectfully submitted that all rejections of record have been obviated. Thus, applicants respectfully request favorable review and passage to issue of this application.

A check in the amount of \$380.00 is attached to cover the required two month extension fee.

HUEFFER et al., Serial No. 09/041,698

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Respectfully submitted,

KEIL & WEINKAUF

A handwritten signature in cursive script, appearing to read "HB Keil".

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